

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Dr. Rudiger KURTZ Group Art Unit: 1734
Appln. No. : 10/619,424 Examiner: B. A. Lamb
Filed : July 16, 2003 Confirmation No.: 7328

For: DEVICE AND PROCESS FOR IMPREGNATING A PAPER OR
CARDBOARD WEB

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop **Appeal Brief - Patents**
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This appeal is from the Examiner's final rejection of claims 1 – 15 and 33 as set forth in the Final Office Action of July 27, 2006.

A Notice of Appeal and a Request for Pre-Appeal Brief Review in response to the July 27, 2006 Final Office Action were filed October 27, 2006. Further, a Notice of Panel Decision from Pre-Appeal Brief Review instructing Appellants to proceed to Board of Patent Appeals and Interferences was forwarded December 5, 2006. Accordingly, the instant Appeal Brief is being timely submitted by the initial due date of January 5, 2007.

The requisite fee under 37 C.F.R. 1.17(c) in the amount of \$ 500.00 for the filing of the Appeal Brief is being paid by check submitted herewith. However, if for any reason the necessary fee is not associated with this file, the undersigned authorizes the charging of any filing fees for the Appeal Brief and/or any necessary extension of time fees to Deposit Account No. 19 - 0089.

(1) REAL PARTY IN INTEREST

The real party in interest is Voith Paper Patent GmbH of Heidenheim, Germany, by an assignment recorded in the U.S. Patent and Trademark Office on October 2, 2003 at Reel 014554 and Frame 0256.

(2) **RELATED APPEALS AND INTERFERENCES**

No related appeals and/or interferences are pending.

(3) **STATUS OF THE CLAIMS**

Claims 1 – 15 and 33 stand finally rejected. Claims 16 – 32, directed to a non-elected invention, have been withdrawn from further consideration.

(4) **STATUS OF THE AMENDMENTS**

No amendments have been entered subsequent to the Final Office Action of July 27, 2006.

(5) **SUMMARY OF CLAIMED SUBJECT MATTER**

The instant invention is directed to a device for impregnating paper or cardboard webs with an impregnating agent (page 2, lines 20 – 21). Moreover, the present invention utilizes an *elastic* compression of the web (page 3, lines 3 – 4), such that a temporary compression is still present when the web enters the coating device (page 3, lines 25 – 26). An agent is applied to the elastically compressed web so that the web becomes soaked with the agent through a deeper penetration of impregnating agent into the web (page 3, lines 2 – 3 and 25 - 26).

Thus, the instant invention compresses the web elastically in the wide nip calender and positions the coating device relative to the wide nip calender in such a manner that the elastic compression of the web is still present when the web enters the coating device (page 3, lines 25 – 26). As it is merely an *elastic* compression, this compression is temporary and is reversed, namely after the application of the impregnating agent (page 3, lines 12 – 14 and 25 – 27, page 2, line 26 – page 3, line 3). The web thus soaks up the impregnating agent, and an extensive penetration of the web with the impregnating agent is achieved without any high pressure being required from outside during the application of the impregnating agent (page 3, lines 3 – 16).

The following descriptions are made with respect to the independent claim and include references to particular parts of the specification. As such, the following is merely exemplary and is not a surrender of other aspects of the present invention that are also enabled by the present specification and that are directed to equivalent structures or methods within the scope of the claims.

Independent claim 1 is directed to a coating device for impregnating a web 7 with an impregnating agent, comprising a coating device 4 structured and arranged to apply the impregnating agent to the web and a wide nip calender 5 located, with respect to a web travel

direction, before a coating device (page 2, lines 22 – 26). The wide nip calender comprises a circulating jacket 18 and a back pressure element 14 arranged to form a wide nip (page 2, lines 22 – 26) and an *elastic compression* of the web (page 3, lines 2 – 3). The distance between said coating device and said wide nip calender is such that *the elastic compression of the web by said wide nip calender is still present when the web enters the coating device* (page 3, lines 25 – 26).

Independent claim 33 is directed to a device for impregnating a web with an impregnating agent, comprising a coating device 4 structured and arranged to apply the impregnating agent to the web 7 (page 2, lines 22 – 26). A wide nip calender 5 located, with respect to a web travel direction, before the coating device 4, comprises a circulating jacket 18 and a back pressure element 14 (page 2, lines 22 – 26) arranged to form a wide nip and an *elastic compression* of the web (page 3, lines 2 – 3). The coating device 4 comprises a film press (page 4, lines 16 – 25).

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether Claims 1 – 15 and 33 are Unpatentable Under 35 U.S.C. § 103(a) over International Publication WO 01/98585 A1 [hereinafter “WO ‘585”].

(7) **ARGUMENT**

(A) The Rejection of Claims 1 – 15 and 33 Under 35 U.S.C. § 103(a) as being Unpatentable over WO '585 is in Error, the Rejection Should be Reversed, and the Application Should be Remanded to the Examiner.

The Examiner asserts that WO '585 shows all of the features of the instant invention, with the exception of a elastic compression of the web and the placement of the wide nip calender relative to the coating device such that the elastic compression of the web by the wide nip calender is still present when the web enters the coating device. The Examiner, however, asserts that it would have been obvious to one ordinarily skilled in the art that the apparatus is capable of elastic compression of the web and that it would have been obvious to one ordinarily skilled in the art to set a distance between the wide nip calender and the coating device so that the elastic compression of the web by the wide nip calender is still present when the web enters the coating device. Appellants traverse the Examiner's assertions.

A rejection under 35 U.S.C. § 103 requires the Examiner to first establish a *prima facie* case of obviousness: "The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicants are under no obligation to submit evidence of nonobviousness." MPEP 2142. The Court of Appeals for the Federal Circuit has set forth three elements, which must be shown for *prima facie* obviousness:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teachings or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir.

1991).

Further, in establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, it is incumbent upon the Examiner to provide a reason *why* one of ordinary skill in the art would have found it obvious to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972 (B.P.A.I. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from Appellants' disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). It is respectfully submitted that the courts have long held that it is impermissible to use Appellants' claimed invention as an instruction manual or "template" to piece together teachings of the prior art so that the claimed invention is purportedly rendered obvious. See *In re Fritch*, 972 R.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

Additionally, Appellants note that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would teach away from the claimed invention. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, Appellants submit that it is improper to combine teachings where a reference teaches away from this combination. See *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

Independent Claim 1:

Appellants' independent claim 1, recites *inter alia*: a wide nip calender located, with respect to a web travel direction, before said coating device, arranged to form an elastic compression of the web, and a distance between said coating device and said wide nip calender

is such that elastic compression of the web by said wide nip calender is still present when the web enters the coating device.

As discussed above, the present invention utilizes an *elastic* compression of the web (page 3, lines 3 – 4), such that a temporary compression is still present when the web enters the coating device (page 3, lines 25 – 26). As it is merely an *elastic* compression, this compression is temporary and is reversed, namely after the application of the impregnating agent (page 3, lines 12 – 14 and 25 – 27, page 2, line 26 – page 3, line 3).

Figure 2 of WO '585 shows a wide nip calender (N) followed by a coating device (S). More specifically, the paper web (W) is calendered in the nip (N) between the hard roll (1) and the soft-faced calendering element (2). When the web (W) has traveled through the calendering nip (N), the web has been pressed into a particular *standard final thickness*. Thereafter, the web (W), having been pressed into its final thickness, is guided to a coating unit (S) in which aqueous substance is spread on the surface of the web. (See Fig. 2, page 1, lines 17 – 19, page 8, line 19 – page 9, line 9).

Modification of Reference not Obvious – Reference Teaches Away

While WO '585 discloses a wide nip calender followed by a coating device, Appellants note that WO '585 expressly discloses that the nip calender presses the paper web into a particular *standard final thickness* (page 1, lines 17 – 19), such that the nip calendering produces a paper web with a *fixed final density* (page 1, lines 26 – 27). Additionally, Appellants submit that WO '585 expressly discloses that the purpose of calendering is to improve the paper quality by pressing the paper in to a particular *standard final thickness* (page 1, lines 17 – 19). As the wide nip calender of WO '585 produces a web with a *final thickness*, Appellants submit that the wide nip calender produces a *permanent compression* of the web, which is wholly inconsistent

with the expressly recited features of *elastic compression*, as recited in at least independent claim 1.

Thus, Appellants submit that the Examiner has not considered WO '585 in its entirety, including the portions of WO '585 that teach away from the present invention. As WO '585 expressly discloses the wide nip calender compresses a web to a *final thickness*, this results in *permanent compression* of the web. While the Examiner asserts that it would have been obvious to one of ordinary skill in the art that the device of WO '585 is capable of elastic compression dependant on the pressure profile and nip length of the wide nip calender which is adjustable via the shoes in the wide nip calender, the Examiner has not pointed to any specific teaching or suggestion in the applied art to support her assertions.

While acknowledging WO '585 discloses on page 7, lines 31 and 32 that the pressure profile and nip length can be adjusted by adjusting the shoe, Appellants submit this fails to even arguably suggest an elastic compression of the web. WO '585 is solely directed to achieving *permanent compression* such that there is no teaching or even an arguable suggestion of achieving *elastic compression*, as recited in the pending claims. That is, as WO '585 expressly discloses that the nip calender presses the paper web into a *final thickness* with a *fixed final density*, permanent compression, not elastic compression, of the web occurs in the wide nip calender of WO '585 before applying a coating.

Further, Appellants note WO '585 produces a *final thickness* for the web to provide certainty in its final coated product. Appellants submit elastic compression would be wholly contrary to this certainty because the elastic compression is temporary, such that the final thickness could not be set by the calendering of WO '585.

Thus, Appellants submit that the Examiner's conclusion of obviousness is improper, as the Examiner has not considered WO '585 in its entirety including the portions that teach away from the claimed invention. As a *final thickness* or a *permanent compression* of the web, as disclosed by WO '585, is directly contrary to an *elastic compression* of the web, as recited in at least independent claim 1, Appellants submit that WO '585 teaches away from the present invention. Therefore, Appellants submit it would not have been obvious to one skilled in the art to modify WO '585 in order to elastically compress a web, as such a modification is contrary to the express disclosure of the applied art.

Additionally, WO '585 discloses on page 4, line 23 to page 5, line 7 that the apparatus is operated such that fibers in the middle of the z-direction may be left unaffected, wherein the bulkiness of the paper is maintained. The Examiner contends that this would infer to one skilled in the art that the WO '585 apparatus is capable of being operated such that elastic compression in the nip occurs since the fibers in the middle in the z-direction of the paper web are left unaffected or not compressed.

Appellants submit, however, that this too teaches away from the present invention. That is, as the fibers in the middle in the z-direction of the paper web in WO '585 are left *unaffected* or *not compressed*, Appellants submit there is still no teaching or suggestion of the recited *elastic compression*. Therefore, Appellants submit it would not have been obvious to one skilled in the art to modify WO '585 in order to elastically compress a web, as such a modification is contrary to the express disclosure of the applied art.

As WO '585 does not teach or suggest an *elastic compression* of the web, the Examiner's contention that it would have been obvious to one skilled in the art to set a distance between the wide nip calender and the coating device such that *the elastic compression of the web by the wide*

nip calender is still present when the web enters the coating device is certainly not supportable by the art of record. As discussed above, as WO '585 discloses permanent compression of the web to produce a web having a *final thickness* and a *fixed final density* and leaving fibers in the middle of the web *unaffected*, this cannot even arguably suggest the elastic compression recited in independent claim 1.

The Examiner contends that the capability of an elastically compressed web to be present in the coating device is dependent upon the amount of resiliency of the web and degree of compression of the web. Notwithstanding this information, WO '585 discloses compressing the web to a final thickness, such that any capability of elastic compression is ended during calendering. Thus, Appellants submit that the express disclosure of WO '585 provides no degree of resiliency of the web and no degree of compression in disclosing permanent compression of the web before coating. Moreover, as WO '585 expressly discloses a *permanent compression*, Appellants submit that this express disclosure precludes the Examiner's conclusion of obviousness. Therefore, Appellants submit that, as there is no elastic compression taught or suggested by WO '585, it would not have been obvious to one skilled in the art to modify WO '585 to set a distance between the wide nip calender and the coating device such that the elastic compression of the web by the wide nip calender is still present when the web enters the coating device.

Because the art of record fails to provide any teaching or suggestion of *elastic compression* of the web, or placement of the coating device relative to the wide nip calender such that *elastic compression of the web is present when the web enters the coating device*, Appellants submit that no proper modification of WO '585 can even arguably render unpatentable the combination of features recited in at least independent claim 1. Thus,

Appellants request that the Board reverse the Examiner's decision to finally reject independent claim 1, and that the application be remanded to the Examiner for early allowance.

No Motivation to Modify Reference

Further, Appellants note that, as WO '585 fails to provide any teaching or suggestion of elastic compression of the web, the art of record fails to suggest the requisite motivation or rationale for modifying WO '585 in any manner that would render unpatentable the combination of features recited in at least independent claim 1.

Additionally, Appellants note that the Examiner has not identified any motivation or rationale for modifying WO '585 in the manner asserted by the Examiner, as required for a proper rejection under 35 U.S.C. § 103(a). Appellants submit that a proper rejection under 35 U.S.C. § 103(a) requires the Examiner to provide a reason *why* one of ordinary skill in the art would have found it obvious to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. However, the Examiner has set forth no such motivation or rationale for modifying WO '585.

Moreover, as the Examiner's asserted modification of WO '585 is wholly contrary to the express disclosure of WO '585, i.e., the applied art expressly requires permanent *not* elastic compression of the web, Appellants submit that the only reasonable basis for modifying WO '585 is the use of improper hindsight after reviewing Appellants' own disclosure. Thus, Appellants request that the Board reverse the Examiner's decision to finally reject independent claim 1, and that the application be remanded to the Examiner for early allowance.

Dependent Claims 2 – 15:

Appellants submit that claims 2 – 15 are allowable at least for the reason that they depend from an allowable base claim.

Accordingly, Appellants submit that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of obviousness under 35 U.S.C. § 103(a). Thus, Appellants request that the Board reverse the Examiner's decision to finally reject dependent claims 2 – 15, and that the application be remanded to the Examiner for early allowance.

Independent Claim 33:

Appellants independent claim 33, recites *inter alia*: a wide nip calender located, with respect to a web travel direction, before said coating device, arranged to form an elastic compression of the web, wherein said coating device comprises a film press.

Modification of Reference not Obvious – Reference Teaches Away

While WO '585 discloses a wide nip calender followed by a coating device, Appellants note that WO '585 expressly discloses that the nip calender presses the paper web into a particular standard *final thickness* (page 1, lines 17 – 19), such that the nip calendering produces a paper web with a *fixed final density* (page 1, lines 26 – 27). Additionally, Appellants submit that WO '585 expressly discloses that the purpose of calendering is to improve the paper quality by pressing the paper in to a particular standard *final thickness* (page 1, lines 17 – 19). As the wide nip calender produces a web with a *final thickness*, Appellants submit that the wide nip calender of WO '585 produces a *permanent compression* of the web, which is wholly inconsistent with the expressly recited feature of *elastic compression*, as recited in at least independent claim 33.

Thus, Appellants submit that the Examiner has not considered WO '585 in its entirety, including the portions of WO '585 that teach away from the present invention. As WO '585 expressly discloses the wide nip calender compresses a web to a *final thickness*, this results in *permanent compression* of the web. While the Examiner asserts that it would have been obvious

to one of ordinary skill in the art that the device of WO '585 is capable of elastic compression dependant on the pressure profile and nip length of the wide nip calender which is adjustable via the shoes in the wide nip calender, the Examiner has not pointed to any specific teaching or suggestion in the applied art to support her assertions.

While acknowledging WO '585 discloses on page 7, lines 31 and 32 that the pressure profile and nip length can be adjusted by adjusting the shoe, Appellants submit this fails to even arguably suggest an elastic compression of the web. WO '585 is solely directed to achieving *permanent compression* such that there is no teaching or even an arguable suggestion of achieving *elastic compression*, as recited in the pending claims. That is, as WO '585 expressly discloses that the nip calender presses the paper web into a *final thickness* with a *fixed final density*, permanent compression, not elastic compression of the web occurs in the wide nip calender of WO '585 before applying a coating.

Further, Appellants note WO '585 produces a final thickness for the web to provide certainty in its final coated product. Appellants submit elastic compression would be wholly contrary to this certainty because the elastic compression is temporary, such that the final thickness could not be set by the calendering of WO '585.

Thus, Appellants submit that the Examiner's conclusion of obviousness is improper, as the Examiner has not considered WO '585 in its entirety including the portions that teach away from the claimed invention. As a *final thickness* or a *permanent compression* of the web, as disclosed by WO '585, is directly contrary to an *elastic compression* of the web, as recited in at least independent claim 33, Appellants submit that WO '585 teaches away from the present invention. Therefore, Appellants submit it would not have been obvious to one skilled in the art

to modify WO '585 in order to elastically compress a web, as such a modification is contrary to the express disclosure of the applied art.

Additionally, WO '585 discloses on page 4, line 23 to page 5, line 7 that the apparatus is operated such that fibers in the middle of the z-direction may be left unaffected, wherein the bulkiness of the paper is maintained. The Examiner contends that this would infer to one skilled in the art that the WO '585 apparatus is capable of being operated such that elastic compression in the nip occurs since the fibers in the middle in the z-direction of the paper web are left unaffected or not compressed.

Appellants submit, however, that this too teaches away from the present invention. That is, as the fibers in the middle in the z-direction of the paper web in WO '585 are left *unaffected or not compressed*, Appellants submit there is still no teaching or suggestion of the recited *elastic compression*. Therefore, Appellants submit it would not have been obvious to one skilled in the art to modify WO '585 in order to elastically compress a web, as such a modification is contrary to the express disclosure of the applied art.

Because the art of record fails to provide any teaching or suggestion of *elastic compression* of the web, Appellants submit that no proper modification of WO '585 can even arguably render unpatentable the combination of features recited in at least independent claim 33. Thus, Appellants request that the Board reverse the Examiner's decision to finally reject independent claim 33, and that the application be remanded to the Examiner for early allowance.

No Motivation to Modify Reference

Further, Appellants note that, as WO '585 fails to provide any teaching or suggestion of elastic compression of the web, the art of record fails to suggest the requisite motivation or

rationale for modifying WO '585 in any manner that would render unpatentable the combination of features recited in at least independent claim 33.

Additionally, Appellants note that the Examiner has not identified any motivation or rationale for modifying WO '585 in the manner asserted by the Examiner, as required for a proper rejection under 35 U.S.C. § 103(a). Appellants submit that a proper rejection under 35 U.S.C. § 103(a) requires the Examiner to provide a reason *why* one of ordinary skill in the art would have found it obvious to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. However, the Examiner has set forth no such motivation or rationale for modifying WO '585.

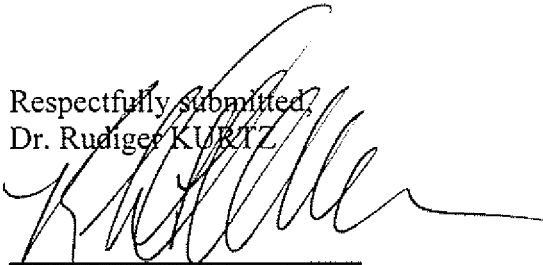
Moreover, as the Examiner's asserted modification of WO '585 is wholly contrary to the express disclosure of WO '585, i.e., the applied art expressly requires permanent *not* elastic compression of the web, Appellants submit that the only reasonable basis for modifying WO '585 is the use of improper hindsight after reviewing Appellants' own disclosure. Thus, Appellants request that the Board reverse the Examiner's decision to finally reject independent claim 33, and that the application be remanded to the Examiner for early allowance.

(B) Conclusion

Claims 1 – 15 and 33 are patentable under 35 U.S.C. § 103(a) over WO '585. Specifically, the applied art of record fails to render unpatentable the unique combination of features recited in Appellants' claims 1 – 15 and 33. Accordingly, Appellants respectfully requests that the Board reverse the Examiner's decision to finally reject claims 1 – 15 and 33 under 35 U.S.C. § 103(a) and remand the application to the Examiner for withdrawal of the rejection and allowance of the pending claims.

Thus, Appellants respectfully submit that each and every pending claim of the present application meets the requirements for patentability under 35 U.S.C. §112, second paragraph, 35 U.S.C. §102(b), and 35 U.S.C. §103(a), and that the present application and each pending claim are allowable over the prior art of record.

Respectfully submitted,
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Attachments: Claims Appendix
Evidence Appendix
Related Proceedings Appendix

8) CLAIMS APPENDIX

The following listing of claims is a listing of the claims currently on appeal:

Listing of Claims

1. (Previously presented) A device for impregnating web with an impregnating agent, comprising:

a coating device structured and arranged to apply the impregnating agent to the web; and

a wide nip calender located, with respect to a web travel direction, before said coating device, said wide nip calender comprising a circulating jacket and a back pressure element arranged to form a wide nip and an elastic compression of the web,

wherein a distance between said coating device and said wide nip calender is such that elastic compression of the web by said wide nip calender is still present when the web enters the coating device.

2. (Original) The device in accordance with claim 1, wherein the impregnating agent comprises a starch solution or other coating agents commonly used in paper upgrading.

3. (Original) The device in accordance with claim 2, wherein the starch solution comprises a starch size.

4. (Original) The device in accordance with claim 2, wherein the web comprises one of a paper or cardboard web.

5. (Original) The device in accordance with claim 1, wherein the impregnating agent is applied to a web having a basis weight over 40 g/m².

6. (Original) The device in accordance with claim 1, wherein, between said wide nip and said coating device, no other web processing devices are provided.

7. (Original) The device in accordance with claim 6, wherein at least one guide device is arranged between said wide nip and said coating device.

8. (Original) The device in accordance with claim 1, wherein said wide nip calender further comprises a heating device.

9. (Original) The device in accordance with claim 8, wherein said heating device is formed by said back pressure element.

10. (Original) The device in accordance with claim 8, wherein said heating device comprises a surface structured to guide the web through said wide nip, and said surface having a temperature adjustable to at least 200°C.

11. (Original) The device in accordance with claim 1, wherein said coating device comprises a film press.

12. (Original) The device in accordance with claim 1, further comprising a drying area located downstream of said coating device.

13. (Original) The device in accordance with claim 12, wherein said wide nip is heated to a temperature higher than a temperature in said drying area.

14. (Original) The device in accordance with claim 1, wherein said wide nip is adjustably heated to at least a plasticizing temperature of web fibers of the web.

15. (Original) The device in accordance with claim 1, further comprising a reeling device arranged downstream of said coating device, wherein no glazing device is arranged between said coating device and said reeling device.

33. (Previously presented) A device for impregnating web with an impregnating agent, comprising:

a coating device structured and arranged to apply the impregnating agent to the web; and

a wide nip calender located, with respect to a web travel direction, before said coating device, said wide nip calender comprising a circulating jacket and a back pressure element arranged to form a wide nip and an elastic compression of the web,

wherein said coating device comprises a film press.

(9) **EVIDENCE APPENDIX**

None.

(10) **RELATED PROCEEDINGS APPENDIX**

None.